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EXAMINER

MENGISTU, AMARE

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 05/29/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/211,942

Applicant(s)

LARSON ET AL. *Y*

Examiner

Amare Mengistu

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 2/6/03 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The amendment filed on February 6, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: **on Page 1 under the title “IN THE DRAWINGS” lines 1-2; under the title “IN THE SPECIFICATIONS” the last 2 lines – page 3.**

2. Applicant is required to cancel the new matter in the reply to this Office Action.
- 3.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 6, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of: **figs 7 and 8; such as:” keypad (104);”audio playback (160); “power (180); “voice translation software (208); “memory (206); and “keyboard (204)”.**

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **“a microphone built into the PDA”** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 2673

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. Claims 4, -27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed has failed to teach one skill in the art the following claimed limitations at the time of the invention:

In claim 4, lines 2-3, the recitation of the claim "*a mobile PDA having a wireless transmitter to transmit electronic voice signals to a personal computer*";

In claim 4, lines 3-4, "*a wireless receiver to receive translated voice information from the PC*";

In claim 4, lines 4-6, "*a touch screen display to enter information in response to physical contact and to visually display the translated voice information*";

In claim 8, line 2, "*a personal computer (PC) having a processor, speech recognition software*";

In claim 12, line 3, "*receiving speech with a microphone*";

Art Unit: 2673

In claim 16, lines 6-7; **"the PC performing voice recognition processing on the electronic voice signals to produce translated text"**;

In claim 16, lines 8-9; **"the PC wirelessly transmitting the translated text to a personal digital assistant (PDA);**

In claim 16, line 10; **"the PDA visually displaying at least part of the translated text"**.

In claims 17 and 22, lines 2-4, "storing electronic voice...but **the PC is not within communicating distance of the stylus"**;

In claim 17, lines 5-6, **"playing the stored electronic voice signals in place of displaying translated text on the PDA if the PC is not within communicating distance of the stylus"**;

In claims 17 and 22, lines 7-8,5-6 respectively "wirelessly transmitting the electronic voice signals from the PDA to the PC, **when the PC is within communicating distance of the stylus"**;

In claim 23, lines 4-5 **"the PC performing voice recognition processing on the electronic voice signals to produce translated text"**;

In claim 23, lines 6 -8, "the PC wirelessly **transmitting the translated text to the PDA**"; "the **PDA wirelessly receiving the translated text**"; **"the PDA visually displaying at least part of the translated text"**;

In claim 24, lines 2-3, **"a microphone built into the PDA outputting electronic voice signals from speech input into the microphone"**;

*In claim 25, lines 2-3, "**a microphone located within a stylus in the immediate vicinity of the PDA** outputting electronic **voice signals from speech input into the microphone**".*

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 4,8,12,24,25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase in claim 4, lines 3-4 "**a wireless receiver to receive translated voice information from the PC**" is unclear. It is not clear how, where and to what the voice is translated?

In claim 4, lines 10-11, the recitation "**a microphone to receive acoustical voice signals**" is not clear. What acoustical voice signal? From where does the microphone receive the acoustical voice?

The recitation of the claim 8, lines 5-6 "**a wireless transmitter to transmit the translated voice data**" is indefinite. It is not clear as to where the translated voice data is transmitted?

In claim 8, lines 14-15 the phrase "**a microphone to receive acoustical voice signals**" is not clear. This recitation is not clear from where the microphone receives the voice.

In claim 8, lines 16-17, "a transmitter located in the housing to ***transmit the electronic voice signals from the microphone***" are confusing. The microphone receives an acoustical voice; however, it is not clear how the microphone transmit an electronic voice. Is this electronic voice the same as the electronic voice generated by the PC processor or the stylus generates its own electronic voice?

In claims 8 and 12, lines 2-4 and 12, lines 7-8 respectively, "***translating the electronic voice signals into translated voice data***" is unclear. What does it mean translating electronic voice signals and voice data? What is the difference between electronic voice and voice data? How does one can translate electronic voice into voice data?

In claims 24 and 25, lines 2-3, the phrase "***a microphone built into the PDA outputting electronic voice signals from speech input into the microphone***" are unclear. How does the electronic voice outputted from the microphone will go back to the microphone?

9. Claims 8 -10 are recites the limitation "***the electronic voice***" in claims 8-10, lines 15-17,1-2 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2673

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4-8,10-12,14-15,18-21,23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stevens, III** (5,769,643) in view of **Ohashi** (5,581,783) and **Parvulescu et al** (5,724,410).

As to claims 4-8,10-12,14-15,18-21,23-27, **Stevens, III** (hereinafter **Stevens**) clearly teaches that a PDA system comprising: a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39); a wireless receiver to receive voice from the PC (see, fig.3 (64,67), col.3, lines 20-22); a touch screen display to enter information in response to physical contact and to visually display the translated voice information (fig.4 (54,56)); col.3, lines 8-22); a stylus having a first end to provide physical contact with the touch screen (fig.4 (55)). Furthermore, **Stevens** also teaches that the PC having a processor (fig.3 (42)); a wireless receiver and transmitter (fig.3 (30)) voice data. Furthermore; **Stevens** teaches the stylus communicating with the PDA (fig.3 (55,62); fig.4 (55,12)).

Stevens did not explicitly teach the stylus having a microphone to receive and a transmitter to transmit a voice signal. However; **Ohashi clearly** states that it is well known for a stylus to have a microphone to receive a voice signal (figs.2, 7 (71)) and a transmitter to transmit the voice signal to the personal computer (same as PDA) (fig.2 (16, 18); col.2, lines 32-53,col.5, lines 38-43). **Ohashi** also teaches that the stylus including a microphone (fig.2 (71)); a switch for the microphone (fig.7 (14), col.6, lines

64- col.7, lines 1) and able to communicate with the personal computer with wire (see, fig.11). It is obvious that the stylus of **Ohashi** has to have a power supply in order to function or to provide the information to the PDA and personal computer.

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to substitute the stylus of Stevens with the that of **Ohashi's** because this is an advancement for **Stevens's** stylus in order to capture an image and voice data with the stylus and transferring the information data into the PDA of **Stevens**.

Stevens as modified by **Ohashi** did not disclose translating voice data. The patent of **Parvulescu et al** is cited to teach that it is conventional for a computer system to convert voice into text and text into voice (see, Abstract, fig.5).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use **Parvulescu's** voice to text converter into the system of Stevens, since this will allow the hearing impeard user to visually see the voice information on a display as text.

12. Claims 9,13,16-17,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ohashi** (5,581,783) in view of **Stevens, III** (5,769,643) and **Parvulescu et al** (5,724,410).

As to claims 16-22, **Ohashi** discloses a stylus (fig.2) wirelessly transmitting electronic voice signals to a personal computer (PC) (fig.2 (16, 18, (a))); col.2, lines 32-53,col.5, lines 38-43); the PC receiving the electronic voice signals (col.2, lines 31-53,fig.3 (32,33 (a))).

Ohashi has failed to disclose that the PC to perform voice translation into text. The patent of **Parvulescu et al** is cited to teach that it is conventional for a computer system to convert voice into text and text into voice (see, Abstract, fig.5).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use **Parvulescu's** voice to text converter into the system of Stevens, since this will allow the hearing impeard user to visually see the voice information on a display as text.

Ohashi as modified by **Parvulescu et al** failed to teach the wirelessly communication between PC and PDA.

Stevens teaches that it is conventional for PC and PDA to communicate wirelessly and displaying the message on the PDA (see, fig.3 col.3, lines 8-22).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to combine the wireless communication system of **Stevens** into the device of **Ohashi**, so that this will allow the user freely to move around without any restrictions.

Response to Arguments

13. Applicant's arguments with respect to claims 4-27 have been considered but are moot in view of the new ground(s) of rejection.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

Art Unit: 2673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

*A.M
May 23, 2003